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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,816	08/06/2001	Klaus-Leo Wilbuer	SWR-0056	4738

23413 7590 06/20/2003

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EXAMINER

KEITH, JACK W

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 06/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/856,816

Applicant(s)
Wilbuer et al

Examiner
Jack Keith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 25, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-58 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 38-58 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Election/Restrictions

1. Upon review of applicant's cancellation of all pending claims and submission of new claims a new election/restriction is warranted. Note the cancellation and submission of new claims does not preclude applicant from making the required election set forth in Paper no. 13. Applicant's newly submitted claims necessitate the new election/restriction requirement.

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. Currently, claim 38 is generic to groups IA-IC. Claim 48 is generic to groups IIA-IIC.

Group IA, 38-47, drawn to a process adapted to produce a product wherein the electrolytically precipitable metallic substance is nickel.

Group IB, claims 38-47, drawn to a process adapted to produce a product wherein the electrolytically precipitable metallic substance is cadmium.

Group IC, claims 38-47, drawn to a process adapted to produce a product wherein the electrolytically precipitable metallic substance is copper.

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Group IIA, claims 48-58, drawn to a product wherein the electrolytically precipitable metallic substance is nickel.

Group IIB, claims 48-58, drawn to a product wherein the electrolytically precipitable metallic substance is cadmium.

Group IIC, claims 48-58, drawn to a product wherein the electrolytically precipitable metallic substance is copper.

3. The inventions listed as Groups IA, IB, IC, IIA, IIB and IIC do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Applicant in Paper no. 14 identifies the special technical feature as a substance having a high neutron cross-section and an electrolytically precipitable metallic substance. The identified special technical feature as set forth by applicant is not Novel. This can be found for instance in the disclosed prior art submitted by applicant. See for instance, US 4,238,299 wherein a process of producing a neutron absorption coating on a substrate is disclosed. Note that boron carbide particles having a high neutron absorption cross-section are added to an electrolytically precipitable metallic substance (i.e., copper) producing a neutron absorbing device on an inorganic substrate (stainless steel).

Thus, as set forth in Annex B of the MPEP wherein the independent claim(s) do not avoid the prior art a review of the dependent claims shall be considered. Reviewing said dependent

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claims reveals numerous species resulting in numerous inventions. Applicant is permitted only one invention per category under PCT rules; however, review of applicant's dependent claims reveals at least three processes and three products negating the one invention per category rule established under PCT rules. Thus Lack of Unity is Proper.

4. Upon election of one of species IA-IC above, the applicant is further required to elect the following as this application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Ia. Embodiment wherein the high neutron absorption cross-section material is boron.

Ib. Embodiment wherein the high neutron absorption cross-section material is gadolinium.

Ic. Embodiment wherein the high neutron absorption cross-section material is cadmium.

Id. Embodiment wherein the high neutron absorption cross-section material is samarium.

Ie. Embodiment wherein the high neutron absorption cross-section material is europium.

If. Embodiment wherein the high neutron absorption cross-section material is dysprosium.

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5. Upon election of one of species Ia-If above, the applicant is further required to elect the following as this application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

li. Embodiment wherein the relative movement is generated by moving the surface to be coated.

lii. Embodiment wherein the relative movement is generated by injecting a gas into the dispersion bath.

liii Embodiment wherein the relative movement is generated by injecting a ultrasonic waves into the dispersion bath.

6. Upon election of one of species li-liii above, the applicant is further required to elect the following as this application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

IAA. Embodiment wherein the process is performed in a glass vessel.

IBB Embodiment wherein the process is performed in a ceramic vessel.

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7. Upon election of one of species IIA-IIC above, the applicant is further required to elect the following as this application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Ila. Embodiment wherein the high neutron absorption cross-section material is boron.

I Ib. Embodiment wherein the high neutron absorption cross-section material is gadolinium.

I Ic. Embodiment wherein the high neutron absorption cross-section material is cadmium.

I Id. Embodiment wherein the high neutron absorption cross-section material is samarium.

I Ie. Embodiment wherein the high neutron absorption cross-section material is europium.

I If. Embodiment wherein the high neutron absorption cross-section material is dysprosium.

8. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: The reasons are the same as those set forth above in section 3.

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9. Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

10. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

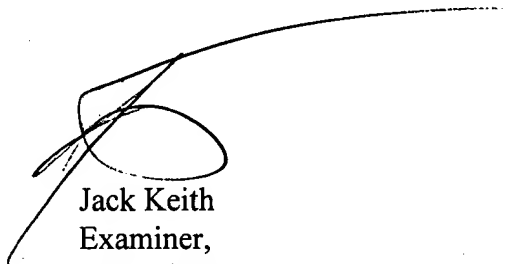
11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Keith whose telephone number is (703) 306-5752. The examiner can normally be reached on Monday through Friday from 7:00 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached on (703) 306-4198. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Jack Keith
Examiner,
Art Unit 3641

jwk

June 18, 2003